

## **REQUEST FOR RECONSIDERATION**

### **Status of the Claims**

Claims 2-13, 15, 17-20, 24-27, 29, 30, and 33-38 are pending, claim 24 being the only independent claim. Claims 19 and 20 have been withdrawn from consideration by the Examiner.

### **Summary of the Office Action**

Claims 19 and 20 stand withdrawn from consideration as being directed to an embodiment of the invention that was non-elected in response to the Examiner's previously imposed restriction requirement.

Claims 2-12, 15, 17, 18, 24-27, 29, 30, 34, and 35 are rejected under 35 USC §103(a) as being unpatentable over KAN (U.S. Design Patent No. 405,591) in view of HOSHIZAKI et al. (U.S. Patent No. 5,498,033, hereinafter "HOSHIZAKI").

Claims 13 and 33 stand rejected under 35 USC §103(a) as being unpatentable over KAN in view of HOSHIZAKI and BOURDEAU (U.S. Patent No. 5,887,886).

### **Response to the Office Action**

#### **A. Withdrawal of Rejection Based Upon KAN and HOSHIZAKI**

Applicant requests that the rejection of claims 2-12, 15, 17, 18, 24-27, 29, 30, and 34-38 under 35 USC §103(a), based upon a combination of KAN and HOSHIZAKI, be withdrawn.

#### **1. Independent Claim 24**

Independent claim 24, directed to a sports boot, includes the following limitations (as well as others): (a) a *flexible frame* affixed to an external upper; (b) at least a part of the lateral portion of the flexible frame (such as lateral arm 15 (see, *e.g.*, Fig. 4 or Fig. 7)) is spaced above the outer sole of the boot of the invention; (c) the lateral portion of the flexible frame is connected to the outer sole of the boot of the invention proximate an area of the metatarsophalangeal joint; and (d) the flexible frame extends above the ankle region of the boot.

As mentioned, claim 24 specifies that the frame is a *flexible* frame, *i.e.*, one that can be flexed (not a *rigid* frame as in KAN, not a *rigid* frame as in BOURDEAU; nor a frame intending merely to *rigidify* the heel of the boot as in HOSHIZAKI).

The rejection includes the following assertions regarding the disclosure of KAN which, Applicant submits, are *not supported by KAN's disclosure*:

- (1) "Kan discloses a sports boot that permits a certain amount of dorsal and plantar flexion";
- (2) KAN's boot comprises "an external upper ... covering a user's foot and lower leg";
- (3) KAN's "external upper [comprises] a flexible frame affixed to [an] external upper";
- (4) The alleged flexible frame of KAN extends "upwardly above an area adapted to cover an ankle of the user";
- (5) The "dorsal portion [is] adapted to cover a rear of the user's lower leg".

On page 3 of the Office action is the statement that "Kan is silent about the material of the frame." In fact, KAN is silent about much more.

Applicant can easily summarize KAN's disclosure. The title of KAN's design is "Decorative Plate for an In-Line Roller Skate." Included are seven drawing figures of the decorative plate. KAN's single claim is "The ornamental design for a decorative plate for an in-line roller skate, as shown and described." Fig. 1 is described as "a perspective view of a decorative plate for an in-line roller skate showing my new design." The descriptions of Figs. 2-7 add nothing, except to identify the nature of the views (*i.e.*, front, left side, right side, top, bottom, perspective).

That is all.

No mention of materials.

No mention of rigidity or flexibility.

As for the assertion in the rejection "Kan discloses a sports boot that permits a certain amount of dorsal and plantar flexion," where is that disclosure?

As for the assertion in the rejection "an external upper ... covering a user's foot and lower leg," where in either the description or the drawing is there a teaching or suggestion that the external upper of KAN's "plate" (or shoe) covers the lower leg? From the broken-line showing in KAN's Fig. 7, it would appear that the "plate" is for a low upper, *i.e.*, one that is below the ankle; it would then not rise to the lower leg.

As for the assertion in the rejection "external upper [comprises] a flexible frame affixed to [an] external upper", where is there a teaching or suggestion that KAN's "plate" is flexible?

As for the assertion in the rejection that the alleged flexible frame of KAN extends "upwardly above an area adapted to cover an ankle of the user", where is there a teaching or suggestion that KAN's "plate" extends above the ankle?

And, as for the assertion in the rejection that the "dorsal portion [is] adapted to cover a rear of the user's lower leg", where is that teaching or suggestion?

The answers for each of the questions posed above is that there is no teaching or suggestion in KAN.

Of course, KAN is a *design* patent and the deficiencies are not surprising.

Incidentally, Applicant's undersigned representative searched the patent data base that is available on-line and was unable to find a utility equivalent of KAN's design patent (by searching patents with the inventor's name "Kan").

In addition to KAN's silence on many issues relating to Applicant's claimed invention, Applicant points out that an in-line roller skate, to which KAN's design is directed, is well known to those skilled in the art as having a chassis with a *rigid base*, which cannot be flexible.

Still further, in *In re Leshin*, 125 USPQ 416, 418 (CCPA 1960), it is stated that "Applicants have the long-recognized right to describe their structures in such language as they choose so long as ordinary meanings are not distorted and if they make themselves clear."

In this regard, KAN describes his invention as a decorative "plate." The first definition of the term "plate" in *The American Heritage Dictionary of the English Language*, Fourth Edition, Houghton Mifflin Company, Boston, 2000, on page 1344 (copy attached) is the following: "1. a smooth, flat, relatively thin, *rigid* body of uniform thickness" (emphasis added).

Thus, while KAN does not explicitly mention flexibility or rigidity, he does use a term which, in its ordinary meaning, encompasses *rigidity*.

At least in view of the foregoing, Applicant submits that not only does KAN fail to teach or suggest a flexible frame, as specified in Applicant's independent claim 24, KAN teaches or suggests a *rigid frame*.

At least for this reason, Applicant submits that the rejections which are based upon KAN should be withdrawn.

If the Examiner is aware of information relating to KAN's disclosure of which Applicant has not been provided, she is kindly requested to describe such information in an affidavit prepared according to 37 CFR §1.104.

The rejection also is contingent upon the viability of the combination, with KAN, of HOSHIZAKI. HOSHIZAKI is relied upon for the alleged obviousness of making the frame of KAN from a flexible non-stretchable material.

The alleged obviousness upon which the rejection relies is premised upon the following assertion: "in order to improve the overall strength and rigidity of the skate boot."

Thus, it is the Examiner's position that the *rigid* plate of KAN is improved in strength and rigidity by substituting, in place of the *rigid* plate, a "*flexible* non-stretchable material."

Applicant respectfully submits that the assertion is illogical in the first instance and should be withdrawn upon reflection.

In addition, Applicant points out that HOSHIZAKI is directed to a skate boot especially used for hockey. The invention of HOSHIZAKI preferably includes an injection molded plastic overlay that is intended to increase the rigidity of the rear of the skate (see column 2, lines 12-16 and 42-44).

## **2. Dependent Claim 9**

Dependent claim 9 specifies that each of the lower ends of the frame is fixed to the lasting allowance.

This feature is not believed to be taught by HOSHIZAKI or KAN. In addition, the subject matter of claim 9 is not addressed in the rejection.

## **3. Dependent Claim 17**

Dependent claim 17 specifies that the dorsal portion of the flexible frame includes a notch that has a lower end that opens out on a recess between the dorsal portion and the outer sole. In the embodiment illustrated in Fig. 7, this notch is shown with reference numeral 134.

The rejection consists of the comment "With regard to claim 17, see Figure 1 embodiment." Applicant submits that the subject matter of claim 17 is not in the Figure 1 embodiment of either KAN or HOSHIZAKI.

## **4. Dependent Claim 18**

Dependent claim 18 specifies that the dorsal portion of the flexible frame is made of two parts, *i.e.*, a rear piece and a front piece (lateral arm), with the front piece including a "fixing

means for fixing the front piece on the rear piece. This subject matter is described in the first paragraph on page 10 of the specification of the instant application.

This feature is not believed to be taught by HOSHIZAKI or KAN. In addition, the subject matter of claim 18 is not addressed in the rejection.

**5. Dependent Claims 37 and 38**

Dependent claims 37 and 38 depend from claims 13 and 33, respectively, and specify that the flexible frame does not extend through a lower surface of said outer sole.

By virtue of its dependency from claim 13, claim 37 further includes the limitation that the flexible frame extends upwardly above the ankle to an area of the middle region of the tibia of the user.

This feature is not taught or suggested by KAN or HOSHIZAKI. See also the Examiner admission in this regard on page 4 of the Office action that KAN fails to disclose this feature.

Similarly, by virtue of its dependency from claim 33, claim 38 further includes the limitation that dorsal portion of the flexible frame is spaced above the outer sole.

This feature is not taught or suggested by KAN or HOSHIZAKI. See also the Examiner admission in this regard on page 4 of the Office action that KAN fails to disclose this feature.

**B. Withdrawal of Rejection Based Upon KAN, HOSHIZAKI, and BOURDEAU**

Applicant requests that the rejection of claims 13 and 33 under 35 USC §103(a), based upon a combination of KAN, HOSHIZAKI, and BOURDEAU be withdrawn.

BOURDEAU is directed to a sport boot having a sole and an attachment member (elements 31, 32) affixed to the sole against movement with respect to the sole. The boot comprises an upper having a rigid internal skeleton extending from a portion of the sole and upwardly at least along a lateral side of the boot. The skeleton constitutes a minimal energy

circuit for the transmission of forces and support, such circuit passing through the attachment means of the boot.

Independent claim 24 is directed to a sports boot that includes an outer sole and an external upper, the upper including a *flexible frame* that made of a substantially *non-stretchable material*. KAN, HOSHIZAKI, and BOURDEAU are directed to rigid or rigidifying structures. As mentioned above, KAN discloses a rigid member (*i.e.*, a "plate"). HOSHIZAKI is concerned with rigidifying the rear of the boot, from the heel to ankle region thereof (see column 1, lines 36-37). HOSHIZAKI's invention is directed to a rigidifying, preferably molded plastic, overlay for the heel of a skate.

Dependent claim 13, rejected upon an alleged obvious combination of KAN, HOSHIZAKI, and BOURDEAU, specifies that the flexible frame extends above the ankle region to about a middle region of a tibia of the user. KAN's plate/shoe does not appear to extend above the ankle region to about the middle of the tibia.

In addition, the plastic overlay of HOSHIZAKI does not extend above the ankle region of the skate; instead, the overlay is *in* the ankle region. In HOSHIZAKI, it is important to allow plantar flexion (column 1, lines 31-33) and, Applicant respectfully submits, it would not appear to one skilled in the art that extending the plastic overlay upwardly further than disclosed by HOSHIZAKI would be consistent with that objective.

Therefore, Applicant would submit that one skilled in the art would not consider modifying the height of the frame of KAN or HOSHIZAKI, by means of a teaching from BOURDEAU or otherwise, in a manner that would have resulted in Applicant's invention as specified in rejected claim 13.

Dependent claim 33, also rejected upon an alleged obvious combination of KAN,

HOSHIZAKI, and BOURDEAU, specifies that the *dorsal portion* of the flexible frame is spaced above the outer sole.

The rejection of claim 33 is premised upon having the dorsal portion of KAN's plate extend from the outer sole substantially up to a top end of the external upper as allegedly taught by BOURDEAU "so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel."

Because KAN's plate is supposedly to be used for an in-line roller skate, in which the shoe would be positioned upon the frame at all times, Applicant questions the need for tactile sensations as one might in other sports. As for the need for shock-absorption or that shock-absorption would be placed between the dorsal portion and the sole, Applicant submits that there is no such teaching in any of the three references relied upon.

Still further, for the boot of the invention, or with the boot of KAN or HOSHIZAKI, having no attachment means like that of BOURDEAU (see element 32 of BOURDEAU), there would have been no need to use the skeleton of BOURDEAU.

In addition, with no skeleton, there would have been no suggestion to one skilled in the art to have made the dorsal part of the plastic overlay of HOSHIZAKI or any structure of KAN higher in view of BOURDEAU.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection of claims 13 and 33 is requested.

#### **SUMMARY AND CONCLUSION**

The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

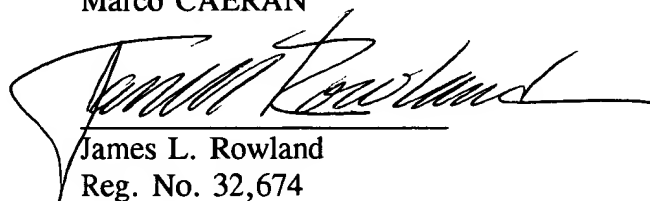


With the withdrawal of the rejections, Applicant also requests that withdrawn claims 19 and 20 be allowed together with the allowance of the claim from which they depend.

No extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089. In addition, any additional required fee, such as a claim fee, can be charged to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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**Attachment:** Page 1344 of *The American Heritage Dictionary of the English Language*, Fourth Edition, Houghton Mifflin Company, Boston, 2000